REMARKS

In response to the Office Action dated May 18, 2006, Applicants respectfully request reconsideration.

Abstract

The Abstract stands objected to as containing over 150 words. The Abstract has been amended to contain 150 or fewer words. Applicants assert that the Abstract complies with 37 C.F.R. § 1.72(b).

35 U.S.C. § 112 rejections

Claims 1-8, 10, and 11-14 stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The plain language of the preambles of claims 1 and 5 make it clear that claims 1 and 5 are drawn to a system, rather than a process. The preamble of claims 1 and 5 recite:

> **A system** providing a measure of performance of participants to a trade management process, said trade management process including transmitting trade-related information between said participants, **said system comprising**:

As such, **the system** is ***providing*** a measure of performance of ***participants to*** *a trade management process*. The recitation of "a system" in the preamble of claims 1 and 5 therefore agrees with the body of claim 1, which recites "a trade management system," "a database," and "a processor" and with the body of claim 5, which recites "a trade management system," "a communication recording system," and "an information processing system."

The plain language of the preamble of claim 10 makes it clear that claim 10 is drawn to a method, rather than a system. The preamble of claim 10 recites:

> **A method** of providing a measure of performance of participants to a trade management process, said trade management process including transmitting trade-related communications between said participants, **said method comprising**:

As such, **the method** is ***providing*** a measure of performance of ***participants to*** *a trade management process*. The recitation of a method in the preamble of claim 10 therefore agrees with the body of claim 10, which recites "providing a trade management system," "receiving a first communication," "receiving a second communication," "recording time information," and "generating a measure of post-trade performance."

Claim 1 stands rejected as reciting "two communications," a "first participate" [sic] and "a first one of the said steps measured," while not reciting a "first communication," "a second participate," [sic] and a "first one of the said steps measured." (Office Action dated 5/18/06, p. 3). Claim 1 has been amended to recite "first and second communications," and "a selected step of said steps." Furthermore, claims 3 and 4, which depend from claim 1, each recite "a second participant." If the Examiner maintains the rejection that claim 1 does not recite "a second participant" (while claims 3 and 4 do), Applicants respectfully request the Examiner to provide a citation to the M.P.E.P. providing a basis for the rejection.

Claims 1-8 stand rejected for the use of the terms "a function of said time-of-completion," "a function of a time elapsed," and "a function of said time information." (Office Action dated 5/18/06, p. 3). Claims 1-8 have been amended to clarify the use of the term "function of."

Claims 1, 3, 4, 6, and 10 stand rejected because "it is not clear from the claim language how the post-trade measure is generated." Claim 1 recites:

> a processor configured to **generate a post-trade measure of performance**, with respect to said first participant, **as a function of a difference between said start time and said time-of-completion, said measure of performance being a function of a time elapsed between**

> **completion of successive ones of said step in said process for closing a trade**.

Thus, the language of claim 1 makes it clear (e.g., generate … as a function of) how the post-trade measure of performance is generated. Claim 6 recites:

> said information processing system is configured **to generate a measure of post-trade performance**, with respect to said first participant, **as a function of a further difference between said start time and said time information for said at least two of said plurality of communications received by said trade management system**.

Thus, the language of claim 6 makes it clear (e.g., generate … as a function of) how the post-trade measure of performance is generated. Claim 10 recites:

> **generating a measure of post-trade performance**, with respect to said first participant, **as a function of said time elapsed between said first communication and said second communication**.

Thus, the language of claim 6 makes it clear (e.g., generate … as a function of) how the post-trade measure of performance is generated.

Thus, for at least the above reasons, Applicants respectfully assert that claims 1-8 and 10 comply with 35 U.S.C. § 112, ¶ 2.

35 U.S.C. § 103 rejections

Claims 1-8 and 10-14 stand rejected under 35 U.S.C. § 103(a). The Examiner states that claims 1-8 and 10-14 stand "rejected under 35 U.S.C. § 103(a) as being unpatentable over (US 6,606,608) Bezos." In the rejection of claims 1, 5, and 10, however, the Examiner also cites "Hawkins" but provides no corresponding U.S. Patent number. The Examiner also failed to cite Hawkins on the "Notice of References Cited" mailed to the applicant along with the May 18, 2006 Office Action and also failed to cite

Hawkins as "prior art made of record and not relied upon." In order to provide a response to the present Office Action, however, the Applicants have assumed that the Examiner's reference to Hawkins refers to U.S. Pat. No. 6,247,000, and will proceed accordingly. If Applicants have assumed incorrectly, Applicants hereby request that the period to reply to the office Action dated May 18, 2006 be restarted under M.P.E.P. § 710.06.

Bezos in view of Hawkins does not teach, disclose, suggest, or make obvious a system, as recited in claim 1, including a processor configured to generate a post-trade measure of performance as a function of a difference between a start time and a time of completion. Furthermore, Bezos discusses a method and a system that is completely different from the claims included in the present application. For example, Bezos is directed to a method and a system for *conducting a computerized auction* rather than methods and systems used with a *trade management process* according to the claims of present application. It is further noted that Bezos does not use the term "trade management process" in the patent.

The Examiner cites col. 14, l. 43 – col. 15, l. 18 and FIG. 11 of Hawkins as teaching "a processor configured to store a post-trade measure of performance with respect to said first participant as a function of said time-of-completion information, said measure of performance being a function of a time elapsed between the said completions of said steps in said trade management process." (Office Action dated 5/18/06, p. 5). The portions of Hawkins cited by the Examiner discuss a flow of messages sent to and from a base system used in the trading of securities. Col. 14, ll. 43-45. An "originating broker 100 writes an order to either buy or sell securities 112 to the executing broker 122." *Id.*, col. 14, ll. 45-47. The server 114 stamps the received order with a time received and adds the originating broker's standing delivery instructions 116. *Id.*, col. 14, ll. 49-53. The server 114 saves the order until the executing broker 122 logs into the system and downloads the order. *Id.*, col. 15, ll. 6-8. Once the executing broker 122 has successfully downloaded the order the server 114 attaches a time stamp indicating when the order was downloaded. *Id.*, col. 15, ll. 15-18. Thus, the communications discussed in Hawkins are pre-trade communications, rather than the post-trade communications recited in claim 1. Furthermore, while Hawkins discusses time stamps, the cited portions

of Hawkins do not disclose that the time stamps are used to generate a post-trade measure of performance as a function of a difference between a start time and a time-of-completion.

In addition to being two unrelated systems (e.g., a computerized auction system and a financial transaction system) that fail to disclose at least a "post-trade measure of performance," Bezos and Hawkins cannot be combined to make obvious claim 1. M.P.E.P. § 2143 states,

> To establish a prima facie case of obviousness, three basic criteria must be met. **First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.** Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants respectfully submit that the combined Bezos and Hawkins references fails to meet at least the first of the criteria for failing to provide a suggestion or motivation to combine the references. Further, in this regard, M.P.E.P. § 2143.01 states,

> Obviousness can **only be established** by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art

(emphasis added). Even if the cited references "may be capable of being modified to run the way the apparatus is claimed, there must [still] be a suggestion or motivation in the reference to do so." M.P.E.P. § 2143.01(III). With the above in mind, not only does the combination of Bezos with Hawkins fail to teach all of claim 1, but also the combination lacks a cogent suggestion to combine the references. Neither Bezos, nor Hawkins discusses a suggestion of generating "a post-trade measure of performance" as does claim 1. Without a motivation to combine two references, a *prima facie* case of obviousness is improper. M.P.E.P. § 2143.01; *see In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1988). Thus, for at least the above reasons, claim 1 is patentable over Bezos in view of Hawkins.

Claims 2-4 and 11-12, which depend from independent claim 1, stand rejected under 35 U.S.C. § 103(a). Thus, for at least the same reasons discussed above with respect to independent claim 1, claims 2-4 and 11-12 are patentable over Bezos in view of Hawkins.

Bezos in view of Hawkins does not teach, disclose, suggest, or make obvious a system, as recited in claim 5, including an information processing system configured to generate a measure of post-trade performance as a function of a difference between a start time and a time value representative of a time when a first communication is received by a trade management system. Furthermore, Bezos discusses a method and a system that is completely different from the claims included in the present application. For example, Bezos is directed to a method and a system for *conducting a computerized auction* rather than methods and systems used with a *trade management process* according to the claims of present application. It is further noted that Bezos does not use the term "trade management process" in the patent.

The Examiner cited col. 1, ll. 32-53 and col. 4, l. 15 – col. 5, l. 67 of Bezos as teaching "an information processing system coupled to said trade management system and configured to generate a measure of post-trade performance with respect to said first participant as a function of said time information for said at least two of a plurality of communications s received by said trade management system." (Office Action dated 5/18/06, p. 8). Bezos discusses a system for conducting an auction wherein a winning bidder receives a discount if specific criterion are met. Abstract. Col. 1, ll. 32-53 of Bezos discuss how the World Wide Web portion of the Internet is used to conduct electronic commerce. Products such as music and books are sold over a server computer system. *Id.* Information provided by a user to the server may include the purchaser's name, the purchaser's credit card number, and a shipping address. *Id.* The server is also configured to send a confirmation to the user. *Id.* The cited portion of Bezos, however, does not disclose a time value representative of a time when a communication was received. Col. 4, l. 15 – col. 5, l. 67 of Bezos discusses the auction system in greater detail, including how the auction system provides for bidder discounts. For example, if the first bidder is ultimately the winning bidder, the bidder can receive a discount. The discount may be borne by the seller or the provider of the auction. *Id.* The cited portion

of Bezos, however does not recite, as does claim 5, an information processing system coupled to a trade management system configured to generate a measure of post-trade performance as a function of a difference between a start time and a time value representative of a time when a first communication is received. If the Examiner maintains the present rejection in a subsequent office action, Applicants respectfully request the Examiner to provide a specific citation in Bezos showing how Bezos discloses generating "a measure of post-trade performance with respect to said first participant as a function of a difference between said start time and said at least one time value."

In addition to being two unrelated systems (e.g., a computerized auction system and a financial transaction system) that fail to disclose at least a "post-trade measure of performance," Bezos and Hawkins cannot be combined to make obvious claim 5. M.P.E.P. § 2143 states,

> To establish a prima facie case of obviousness, three basic criteria must be met. **First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.** Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants respectfully submit that the combined Bezos and Hawkins references fails to meet at least the first of the criteria for failing to provide a suggestion or motivation to combine the references. Further, in this regard, M.P.E.P. § 2143.01 states,

> Obviousness can **only be established** by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art

(emphasis added). Even if the cited references "may be capable of being modified to run the way the apparatus is claimed, there must [still] be a suggestion or motivation in the reference to do so." M.P.E.P. § 2143.01(III). With the above in mind, not only does the combination of Bezos with Hawkins fail to teach all of claim 5, but also the combination

lacks a cogent suggestion to combine the references. Neither Bezos, nor Hawkins discusses a suggestion of generating "a post-trade measure of performance" as does claim 5. Without a motivation to combine two references, a *prima facie* case of obviousness is improper. M.P.E.P. § 2143.01; *see In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1988). Thus, for at least the above reasons, claim 5 is patentable over Bezos in view of Hawkins.

Claims 6-8, which depend from independent claim 5, stand rejected under 35 U.S.C. § 103(a). Thus, for at least the above reasons discussed with respect to claim 5, claims 6-8 are patentable.

Bezos in view of Hawkins does not teach, disclose, suggest, or make obvious a method, as recited in claim 10, including generating a measure of post-trade performance as a function of a time elapsed between a first post-trade communication and a second post-trade communication. Furthermore, Bezos discusses a method and a system that is completely different from the claims included in the present application. For example, Bezos is directed to a method and a system for *conducting a computerized auction* rather than methods and systems used with a *trade management process* according to the claims of present application. It is further noted that Bezos does not use the term "trade management process" in the patent.

The Examiner cited col. 4, l. 59 – col. 5, l. 51 of Bezos as teaching "generating a measure of performance with respect to said first participant as a function of the time elapsed between the first communication and the second communication." (Office Action dated 5/18/06, p. 10). The cited portion of Bezos discusses how the auction system provides discounts to bidders other than a first bidder. *Id.*, col. 4, ll. 59-60. The cited portion of Bezos does not disclose generating a measure of post-trade performance as a function of a time elapsed between a first post-trade communication, and a second post-trade communication. If the Examiner maintains the present rejection in a subsequent office action, Applicants respectfully request the Examiner to provide a specific citation in Bezos showing how Bezos discloses generating "a measure of post-trade performance as a function of a time elapsed between a first post-trade communication and a second post-trade communication."

In addition to being two unrelated systems (e.g., a computerized auction system and a financial transaction system) that fail to disclose at least a "post-trade measure of

performance," Bezos and Hawkins cannot be combined to make obvious claim 10. M.P.E.P. § 2143 states,

> To establish a prima facie case of obviousness, three basic criteria must be met. **First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.** Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicants respectfully submit that the combined Bezos and Hawkins references fails to meet at least the first of the criteria for failing to provide a suggestion or motivation to combine the references. Further, in this regard, M.P.E.P. § 2143.01 states,

> Obviousness can **only be established** by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art

(emphasis added). Even if the cited references "may be capable of being modified to run the way the apparatus is claimed, there must [still] be a suggestion or motivation in the reference to do so." M.P.E.P. § 2143.01(III). With the above in mind, not only does the combination of Bezos with Hawkins fail to teach all of claim 10, but also the combination lacks a cogent suggestion to combine the references. Neither Bezos, nor Hawkins discusses a suggestion of generating "a post-trade measure of performance" as does claim 10. Without a motivation to combine two references, a *prima facie* case of obviousness is improper. M.P.E.P. § 2143.01; *see In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1988). Thus, for at least the above reasons, claim 10 is patentable in view of Bezos in view of Hawkins.

Claims 13-14, which depend from independent claim 10, stand rejected under 35 U.S.C. § 103(a). For at least the reasons discussed above with respect to independent claim 10, claims 13-14 are patentable over Bezos in view of Hawkins.

Conclusion

Based on the foregoing, this application is believed to be in allowable condition, and a notice to that effect is respectfully requested. If a telephone conversation with Applicant's representative would help expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at (617) 542-6000.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account 50-0311, Reference No. 20558-011.

Respectfully submitted,

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